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International Business Machines Corporation
Intellectual Property Law Department
Internal Zip 4054
11400 Burnet Road
Austin, TX 78758

EXAMINER

MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/24/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,223

Applicant(s)

MCBREARTY ET AL.

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment B (paper #8) 17 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment (Paper # 8) filed on April 17, 2004. Claims 1-21 remain pending. Claims 22-24 have been newly added.
2. Claims 1-24 are presented for further examination.
3. The objection held against the abstract has been withdrawn.
4. Double Patenting rejection will be held until allowable subject matter is indicated at which time applicant has agreed to file a timely terminal disclaimer.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 6-9, 13-16 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanaswami (U.S. 6,182,113).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Narayanaswami teaches a world wide web communications network with user access via a plurality of data processor controlled interactive receiving display stations for displaying requested hypertext web documents of at least one display page containing text and images, a system for reducing the downloading time of predetermined hypertext documents requested from said Web comprising:

means at a receiving display station for downloading said requested hypertext Web document in a hypertext mode [**Narayanaswami -- Col. 4 lines 6-9 and lines 13-18 -- Web browser, running on client PC, allows access to and downloads Web documents**],

means enabling a user at said receiving display station to preselect said requested hypertext Web documents to be downloaded in a text-only mode [**Narayanaswami -- Col. 5 lines 26-30 and Col. 6 lines 38-45 -- Bookmark scheduler allows user to enter bookmarks before viewing a website and define properties associated with a particular bookmark, i.e. text-only, either during given hours or with a given connection or all the time**],

means for determining whether a requested hypertext Web document has been preselected for downloading in a text-only mode [**Narayanaswami -- Col. 5 lines 26-30 -- Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have**], and

means responsive to said determining means for downloading said requested preselected hypertext Web document in a text-only mode [Narayanaswami -- Col. 7 lines 10-15 – **Document is downloaded based on criteria specified by the user, i.e. text-only**].

With respect to claim 2, Narayanaswami further teaches means for bookmarking selected requested hypertext Web documents to thereby store at said receiving display station, direct links to the documents for future access [Narayanaswami -- Col. 4 lines 47-49 and lines 53-56 –

Bookmarks, including multiplexed bookmarks, can be stored by the user on the client PC],

said bookmarking means including said means enabling the user to preselect said text-only mode to thereby enable the user to preselect whether the bookmarked hypertext Web document will be downloaded in a text-only mode when received [Narayanaswami -- Col. 5 lines 26-30 and Col. 6 lines 38-45 – **User defines events or criteria regarding the preselected bookmarks, i.e. text-only downloads for certain bookmarks, so that when accessed, page will be downloaded as specified by the user**].

With respect to claim 6, Narayanaswami further teaches a Web browsing means at said receiving display station including:

said means for bookmarking [Narayanaswami -- Col. 4 lines 47-49 and lines 53-56 – **Bookmarks, including multiplexed bookmarks, can be stored by the user on the client PC],**
and

said means for determining whether a requested hypertext Web document has been preselected for downloading in a text-only mode [Narayanaswami -- Col. 5 lines 26-30 –

Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. In addition, Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have].

With respect to claim 7, Narayanaswami further teaches means at said receiving display station for storing said user's preselection of hypertext Web documents to be downloaded in a text-only mode [Narayanaswami -- Col. 4 lines 47-56 and Col. 6 lines 38-45 – **Bookmarks, stored at the client PC, contain user defined events, i.e. text-only mode, which will download a given bookmark or document in text-only mode].**

With respect to claims 8-9 and 13-14, these are method claims corresponding to the system claimed in claims 1-2 and 6-7. They have similar limitations; therefore, claims 8-9 and 13-14 are rejected under the same rationale.

With respect to claim 15, Narayanaswami teaches a computer program having code recorded on a computer readable medium for reducing the downloading time of predetermined hypertext documents of at least one display page containing text and images accessed at a web display station [Narayanaswami -- Col. 4 lines 53-56 – **System is implemented in browser or other software entity which, inherently, is comprised of instructions residing on the hard disk of the PC].** The remaining limitations of claim 15 are similar to the limitations of the method claimed in claim 1. Therefore, claim 15 is rejected under the same rationale.

With respect to claims 16 and 20-21, these are computer program limitations corresponding to the system claimed in claims 2 and 6-7. They have similar limitations; therefore, claims 16 and 20-21 are rejected under the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 1 and 3 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claim 3, Narayanaswami teaches the invention substantially as claimed, as aforementioned in claim 1 above, including preselecting sites through bookmarks to be downloaded in a text-only mode. Narayanaswami, however, fails to teach preselecting domains. Duvall discloses a filtering system which allows users to preselect families of URL's, i.e. domains to cause a given event to occur when a site from the family is selected [**Duvall -- Col. 7 line 5 and line 8**].

Both Narayanaswami and Duvall are concerned with defining properties for given

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websites/family of websites, such that when accessed, the property associated with the site is executed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the preselecting of domains for applying a given event or condition, as taught by Duvall into the invention of Narayanaswami, in order to provide a more efficient system such that users do not have to spend time entering their criteria for each site. In addition, it also provides that the system will be more efficient because it does not have to check if the specific site is listed, only if it belongs to a particular domain.

Regarding claim 4, Narayanaswami-Duvall teach the invention substantially as claimed, as aforementioned in claim 3 above, wherein said user is enabled to preselect web sites **[Narayanaswami -- Col. 4 lines 50-51 -- Bookmarks, which are specific URL's or websites, are preselected and entered into scheduler]** from which all requested hypertext documents will be downloaded in-text-only mode-**[Narayanaswami -- Col. 5 lines 26-30 -- Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have].**

Regarding claim 5, Narayanaswami-Duvall teach the invention substantially as claimed, as aforementioned in claim 3 above, a web browsing means at said receiving display station including:

said means for enabling a user at said receiving display station to preselect domains from which all requested hypertext Web documents will be downloaded in a text-only mode [**Duvall - Col. 7 line 5 and line 8 – System allows users to preselect families of URL's, i.e. domains to cause a given event to occur when a site from the family is selected**], and

said means for determining whether a requested hypertext Web document has been preselected for downloading in a text-only mode [**Narayanaswami -- Col. 5 lines 26-30 – Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have**].

9. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 8 and 10 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claims 10-12, these are method claims corresponding to the system claimed in claims 3-5. They have similar limitations; therefore, claims 10-12 are rejected under the same rationale.

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10. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 15 and 17 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claims 17-19, these are computer program claims corresponding to the system claimed in claims 3-5. They have similar limitations; therefore, claims 17-19 are rejected under the same rationale.

11. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 1, 8 and 15 above respectively, in view of Dan et al. (U.S. 6,560,639).

----- Regarding claim 22, Narayanaswami teaches the invention substantially as claimed, as -----
aforementioned in claim 1 above, but fails to explicitly teach wherein said text-only mode is an ASCII mode.

Dan, however, teaches this limitation fully, by disclosing a web management system whereby users can download comma-delimited ASCII files which are text-only versions of a webpage for users without standard graphical user interface browser capabilities [**Dan -- Col. 2 lines 19-41 and Col. 28 lines 16-21**].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ASCII file mode for text-only, as taught by Dan into the invention of

Narayanaswami, in order to common and well-known mode for creating and transferring text data to users which provides high reliability for a user being able to view the contents on any machine because of the use of the standard mode for a text file.

Regarding claim 23, this is a method claim corresponding to the system claimed in claim 22. It has similar limitations; therefore, claim 23 is rejected under the same rationale.

Regarding claim 24, this is a computer program claim corresponding to the system claimed in claim 22. It has similar limitations; therefore, claim 24 is rejected under the same rationale.

Response to Arguments

12. Applicant's arguments filed April 17, 2004 have been fully considered but they are not persuasive.

- (A) Applicant contends that Narayanaswami has two different web pages, one text-only and one with full graphics, whereas instant invention calls for a single web page which is to be downloaded in such a way which converts the page to a text-only version.

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In response to argument A, Examiner asserts the details provided in the argument are not sufficiently brought out within the claim language to have the argument read on the instant claim (claim 1). It is noted that the features upon which applicant relies (i.e., a single web page exists which can be downloaded in such a way as to convert the page to text-only) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, Examiner has noted the change from web documents to web document in the independent claims. This term, however, does not provide sufficient narrowness to mean a single version of a document. Interpreted broadly, a web document can be construed as a particular page's contents, i.e. a forecast page from weather.com. Thus, even if two pages exist, one for text and one for graphics, both contain the same web document. The only difference is the format, i.e. version, in which they are formatted. Thus, for the claim to inherit the meaning provided in the arguments section by the applicant, further narrowing is necessary. Finally, even if a limitation is added, i.e. converting the document at the receiving computer, it has been noted by the applicant that converting a page from graphics with text to text-only by a receiving computer is well-known in the art and is not novel (See **Amendment B page 11 and specification page 3**). During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Giving the instant claims their broadest reasonable interpretation, "web document" is broad enough to read on the separate page versions with the same content of Narayanaswami.

- (B) Applicant contends that Narayanaswami assigns separate bookmarks for the graphics enabled and text-only webpage, whereas claim 2 calls for a single bookmark.

In response to argument B, Examiner asserts that a single bookmark on the user's computer is made to access a given webpage. Figures 2 and 3A clearly show that multiple bookmarks are only made for different page sources, not one for a text-only version and one for a full graphics version [Narayanaswami -- Col. 5 lines 14-25 and Col. 6 lines 23-41]. As figure 3A shows, the same bookmark, in this case "WS A" is used to access both the graphics version and the text-only version of the particular weather source. Bookmark scheduler, located on the client, is responsible for providing the multiplexing functionality for the bookmarks, namely, to choose which version of the web document is downloaded [Narayanaswami -- Col. 5 lines 26-30 and lines 46-55]. Therefore, examiner accordingly demurs to this assertion as the user must only store one single bookmark to a given weather source to access both the full graphics and text-only versions of the web document from the given source.

- (C) Applicant contends that Narayanaswami does not store a list defining which web documents are to be downloaded in a text-only mode, whereas, claim 7 of the applicant's invention calls for this limitation.

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In response to argument C, Examiner asserts that Narayanaswami stores a list defining what version of a given web document will be downloaded for a given situation, i.e. a particular time period of the day. Thus, for example, when a user wishes to view a weather forecast from weather source A (WS A), by clicking on a Weather Source A bookmark, the system selects the proper link by comparing the present time with the schedule for downloading content from that site stored in the scheduler [Narayanaswami -- Col. 5 lines 46-55]. As shown in Figure 3A, during the morning hours (8:30 a.m. – Noon), WS A will be downloaded in full graphics version, whereas during any other time period other than Noon – 4:30 p.m., a text-only version of WS A, i.e. document, will be downloaded. In addition, instead of time of day, bandwidth can be used as criteria to select which version of the web document will be downloaded [Narayanaswami -- Col. 5 lines 64-67 – Col. 6 lines 1-9]. In light of the above remarks, Examiner demurs to the assertion that multiple bookmarks are stored, as it has been pointed out that in fact only one bookmark per source, i.e. weather source (weather.com, intellicast.com, accuweather.com) is stored, and furthermore, that it is the responsibility of the scheduler to compare the selection made to criteria to determine which version to download.

- (D) Applicant contends that the combination of Narayanaswami and Duvall is unfounded, specifically there is no relation between Narayanaswami and Duvall to provide motivation.

In response to argument D, Examiner asserts that an analogous relationship exists between both Narayanaswami and Duvall which provides for properly combining the two references. While Duvall and Narayanaswami may be concerned with different reasons for filtering the downloading of web documents, both nonetheless are still actively filtering web document requests to determine whether a given type of document should or should not be provided. In response to applicant's argument that Duvall is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the fact that both are concerned with filtering document requests is enough to be reasonably pertinent. In addition, Duvall preselects a list of documents which are to be filtered out [**Duvall -- Col. 7 line 5 and line 8**], which again, relates back to a similar method in Narayanaswami, namely, preselecting web documents to be filtered, i.e. to be downloaded in a text-only mode. Finally, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the case of Narayanaswami, he does in fact take into account the web site or source of the web document when deciding on filtering. This can be seen in figure 3B, as Narayanaswami recognizes that content on a weather

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site can be graphically intense as images, i.e. satellite and radar, can be contained on these types of pages which would slow the download process [Narayanaswami -- Col. 6 lines 1-9]. In conclusion, Examiner demurs to the assertion that Duvall and Narayanaswami are not from an analogous art and furthermore that there is no motivation to combine.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM

June 14, 2004



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100